

REMARKS

Claims 8, 9, 10, 23, and 25 are amended for purposes of clarification and not for purposes of patentability. Claim 32 is amended merely to correct a minor typographical error. Claims 3, 12-14, 16-18, 24, and 26-31 are canceled without prejudice. The amendments are made for the purpose of expediting prosecution and not for patentability, and the claim cancellations are made without prejudice.

Applicants reserve the right to pursue subject matter of the original claims (prior to amendment) and subject matter of the canceled claims in subsequent prosecution.

The allowance of claims 19-21, 32 and 33 is acknowledged. Applicants thank the Examiner for this recognition of patentable subject matter. Claims 34 and 35 are not addressed by the Office Action. However, these claims are thought to be allowable because they depend from allowed claim 33.

Claims 1-2, 4-11, 15, 19-23, 25, and 32-35 remain for consideration and are thought to be in condition for allowance. Therefore, reconsideration and allowance of the application is respectfully requested.

The Office Action does not establish that claims 1-7 are unpatentable under 35 USC §103(a) over “Shen” (U.S. patent no. 6,829,751 to Shen et al.). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Shen, and fails to show that the combination could be made with a reasonable likelihood of success. In view of the amendments made to the claim 1, however, the rejection is now moot and should be withdrawn.

The amendment of claim 1 now generally clarifies the selecting of test signals for input to an embedded core, similar to allowed claim 32. The in combination of limitations is not understood to be suggested by the prior art. Therefore, claims 1-2 and 4-7 are thought to be in condition for allowance.

The Office Action does not establish the unpatentability of claims 8-18 and 22-31 over “Beebe” (U.S. patent no. 6,021,513 to Beebe et al.) in view of Shen. The Office Action apparently has a typographical error in stating this rejection under 35 USC §102(b) because establishing anticipation with two reference is thought to be

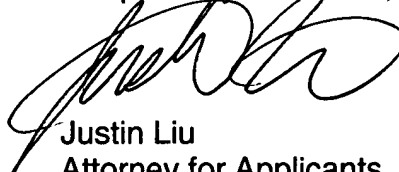
generally improper. Therefore, the traversal of the rejection assumes that the rejection was intended to be made under 35 USC §103(a). The rejection is respectfully traversed because the Office Action fails to show that all the limitations are suggested by the references, fails to provide a proper motivation for modifying the teachings of Beebe with teachings of Shen, and fails to show that the combination could be made with a reasonable likelihood of success. However, the rejection is now moot in view of the amendments made to the claims.

Independent claim 8 is amended to further clarify the isolation of the embedded core device from the Gasket. Independent claims 11 and 22 are amended to further clarify the selection of test input signals. Independent claims 16, 26, and 29 are canceled, along with their respective dependent claims, for purposes of expediting prosecution. Claims depending from claims 8, 11, and 22 are amended for consistency with their respective base claims. The combination of limitations in the remaining claims 8-11, 15, 22-23, and 25 are not thought to be suggested by the prior art.

CONCLUSION

No new matter has been introduced by any of the above amendments. All claims are now in condition for allowance, and accordingly, a Notice of Allowance is respectfully requested. If there are any questions, the undersigned may be contacted at the telephone number listed below.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on August 2, 2005.

Julie Matthews
Name


Signature